

Amendment and Response

Serial No.: 10/632,070

Confirmation No.: 2056

Filed: 31 July 2003

For: TEARABLE ELASTIC COMPOSITE ARTICLE AND METHOD OF MANUFACTURE

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Remarks

The Office Action mailed 25 February 2005 has been received and reviewed. Claim 13 having been amended and new claims 42-43 presented, the pending claims are claims 1-43, with claims 19-41 withdrawn from consideration by the Examiner.

Claim 13 was amended merely to present the claim in independent form. No new matter was added as a result of this amendment.

New claims 42-43 have been added to provide more comprehensive protection of the invention. Support for the new claims can be found in the application as filed at, e.g., p. 11, lines 17-23.

Reconsideration and withdrawal of the rejections in view of the following comments are respectfully requested.

Allowable Subject Matter

Applicants thank the Examiner for notification to the effect that claim 13 would be allowable if rewritten in independent form.

Affirmation of Provisional Election

The Examiner issued a Restriction Requirement under 35 U.S.C. 121 in the above-identified application, grouping the claims as follows: Group I, Claims 1-18 drawn to a product and Group II, Claims 19-41 drawn to a process. A provisional election to prosecute claims 1-18, Group I, was made in response to a telephone conversation between the Examiner and Applicants' Representative, Nancy M. Lambert, on 9 February 2005. The provisional election to prosecute Group I is herein affirmed with traverse.

In support of this restriction requirement, it is asserted that "the product can be made by a materially different process such as by forming the tear pattern in the product after laminating the layers of the product." Applicants respectfully disagree.

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As discussed in the specification at, e.g., p. 11, lines 17-23, the methods of the present invention may be used to provide elastic composite articles in which "each elastic filament of the plurality of elastic filaments extends continuously over the entire length of the article" as recited in independent article claims 1 and 18. Forming the tear pattern after lamination as asserted in support of this restriction requirement would, in all likelihood, sever the elastic filaments such that the above-quoted recitation of article claims 1 and 18 would not be met.

For at least the above reasons, Applicants respectfully request reconsideration of the restriction requirement.

Obviousness-Type Double Patenting Rejection

Claims 1-12 and 14-18 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-38 of co-pending application no. 10/952,798 in view of Swanson et al. (U.S. Patent No. 6,383,958 B1) and WO 95/06449.

Upon an indication of otherwise allowable subject matter and in the event this rejection is maintained, Applicants will provide an appropriate response.

The 35 U.S.C. §102 Rejection

The Examiner rejected claims 1-4, 7-12, and 15-18 under 35 U.S.C. §102(b) as being anticipated by WO 95/06449. This rejection is respectfully traversed.

For a claim to be anticipated under 35 U.S.C. § 102(b), each and every element of the claim must be found in a single prior art reference (M.P.E.P. §2131). Applicants respectfully assert that WO 95/06449 fails to teach each and every element of the rejected claims.

Claims 1 and 18 of the present application each recite an elastic composite article including, *inter alia*, "a plurality of elastic filaments located between the first coverweb and the second coverweb, the plurality of elastic filaments aligned along the length of the article, wherein

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each elastic filament of the plurality of elastic filaments extends continuously over the entire length of the article."

In contrast, WO95/06449 recites elastic wraps in which laminated composites that include elastic filaments are perforated after lamination. As a result, elastic filaments in the article are severed as part of the perforation process and thus cannot extend "continuously along the length of the article" as recited in claims 1 and 18.

For at least the above reasons, Applicants respectfully assert that claims 1-4, 7-12, and 15-18 are novel in view of WO 95/06449. Reconsideration and withdrawal of the rejection of these claims are, therefore, respectfully requested.

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Page 14 of 16**The 35 U.S.C. §103 Rejections**

The Examiner rejected claims 6 and 14 under 35 U.S.C. §103(a) as being unpatentable over WO 95/06449. This rejection is respectfully traversed.

To establish a *prima facie* case of obviousness, three basic criteria must be met.

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

Finally, the prior art references must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143.

As indicated above, Applicants respectfully assert that WO 95/06449 fails to teach independent claim 1. As claims 6 and 14 are directly or indirectly dependent upon claim 1, Applicants assert that the Examiner has not presented a *prima facie* case of obviousness with regard to claims 6 and 14 for at least the reason that WO 95/06449 fails to teach or suggest each element of the rejected claims.

Reconsideration and withdrawal of the rejection of claims 6 and 14 are, therefore, respectfully requested.

The Examiner rejected claims 1-6, 8-12, 14, and 16-18 under 35 U.S.C. §103(a) as being unpatentable over Hansen et al. (U.S. Patent No. 4,984,584) in view of Swanson et al. (U.S. Patent No. 6,383,958 B1). This rejection is respectfully traversed.

Applicants respectfully submit that the asserted motivation to combine/modify the references does not meet the requirements for a *prima facie* case of obviousness. "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP § 2143.01, p. 2100-131, 8th Ed. (Rev. 2, May 2004) (*citing In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

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Hanson et al. teach a high elastic modulus, cohesive bandage to provide joint support (Hanson et al., abstract). As indicated by the Examiner, the bandages of Hanson et al. do not include tear lines. Furthermore, as the bandages of Hanson et al. are directed to providing joint support, Applicants submit that tear lines in these bandages would be disadvantageous, as they would likely provide a weakened bandage that would not supply adequate support, and may even separate under the stress of use.

Because the asserted combination/motivation of introducing tear lines into the compression bandages of Hanson et al. could be expected to render the bandages unsuitable for their intended purpose, Applicants respectfully submit that no motivation sufficient to support a case of *prima facie* obviousness has been identified in connection with this rejection.

For at least the above reasons, Applicants submit that a *prima facie* case of obviousness has not been established for the rejection of claims 1-6, 8-12, 14, and 16-18 under 35 U.S.C. §103(a) as being unpatentable over Hansen et al. in view of Swanson et al. Reconsideration and withdrawal of the rejection are, therefore, respectfully requested.

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It is respectfully submitted that the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
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25 MAY 2005

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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s), as described hereinabove, are being transmitted by facsimile in accordance with 37 CFR §1.6(d) to the Patent and Trademark Office, addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 25th day of May, 2005, at 4:25 PM (Central Time).

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